

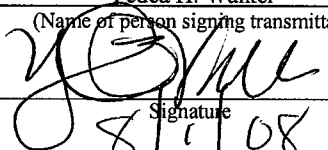
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Susumu Nakagawa
Serial No. : 09/878,581
Filed : June 11, 2001
For : IMAGE CONTENT AND ADVERTISEMENT DATA
PROVIDING METHOD, SYSTEM, AND APPARATUS (AS
AMENDED)
Examiner : Sheleheda, James R.
Art Unit : 2623
Confirmation No. : 2762

745 Fifth Avenue
New York, NY 10151
(212) 588-0800

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted via
Electronic Filing Services on August 1, 2008.

Yedea H. Walker
(Name of person signing transmittal)

Signature
8/1/08
Date of Signature

PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 C.F.R. § 1.144

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 1, 2008

Dear Sir:

This Petition from a Requirement for a Restriction is filed in response to the Office
Action dated July 17, 2008 (Paper No. 20080710) in which the Examiner made the Restriction
Requirement Final.

REMARKS

This petition is filed after a final requirement for restriction dated July 17, 2008.

The facts in the case are as follows:

1. A restriction requirement was issued on May 20, 2005, in which the Applicant was required to elect group I claims 1-22 and 28-30 drawn to a method and apparatus for providing image content and insertion of advertisements into image content, or group II claims 23-27 and 31 directed to a charge totalizing method for totaling the charge of advertisements to an advertiser.

2. A response was filed on June 9, 2005, electing group I claims 1-22 and 28-30.

3. An Office Action dated September 13, 2005, was issued.

4. An amendment dated December 9, 2005, was filed in response to the Office Action. The claims in the application were amended.

5. A Final Office Action was issued on June 29, 2006.

6. An amendment dated August 17, 2006, was filed in which claims were amended.

7. An Advisory Action dated September 6, 2006, was issued.

8. A Request for Continued Examination was filed on September 19, 2006.

9. An Office Action dated January 4, 2007, was issued.

10. A response dated April 3, 2007, was filed in which no amendments were made to the claims.

11. A Final Office Action dated July 24, 2007, was issued.

12. In response to the Final Rejection, a Request for Continued Examination and a Preliminary Amendment were filed on October 19, 2007. In the Preliminary Amendment, the existing claims were not amended and new claims 32-37 were added.

13. An Office Action dated November 27, 2007, was issued.

14. In response to the Office Action, an amendment was filed on February 19, 2008. In this amendment, all independent claims were amended.

15. In response to Applicants amendments, the Examiner issued a restriction requirement dated May 22, 2008 in which the Applicants were to elect group I claims 1-9, 18, 20, 28 and 32-36; group II claims 10-17, 19, 22, 30 and 37; or group III claims 21-29.

16. In response to the restriction requirement, Applicant responded on June 20, 2008 provisionally electing group I claims 1-9, 18, 20, 28 and 32-36. In addition, Applicant traversed the Examiner's rejection of the claims as improper under 37 C.F.R. § 1.142.

This petition is filed in which the Applicant respectfully requests the Director withdraw the Examiner's restriction requirement and reissue the Office Action dated July 17, 2008, in which all pending claims (claims 1-22, 28-30 and 32-37) are examined.

Applicant respectfully points out that the Examiner's restriction requirement is improper and should be withdrawn. Applicant respectfully points out that 37 C.F.R. § 1.142 states that a restriction requirement "will normally be made before any action on the merits; however, it may be any time before final action" (emphasis added). Applicant respectfully points out that two Final Office Actions have been issued in the present application, including Office Actions dated June 29, 2006, and July 24, 2007. Therefore, the Examiner's restriction requirement is made after final action and is therefore improper.

Additionally, Applicant respectfully points out that MPEP § 811 states that the Examiner will consider whether there will be a serious burden if restriction is not required. Applicant respectfully points out that there can be no serious burden on the Examiner since all claims in the present case have been examined by the Examiner in the Office Actions dated September 13, 2005, June 29, 2006, January 4, 2007, July 24, 2007, and November 27, 2007.

In the Office Action dated July 17, 2008, the Examiner stated that the restriction requirement is proper and based upon the Amendment filed February 19, 2008, which is made after a non-final rejection. Applicant respectfully submits that the Examiner's reasoning is incorrect. Applicant respectfully points out that in the Office Action dated November 27, 2007, the Examiner examined all the pending claims in the application. For example, the Examiner's rejection of withdrawn claim 21 is found on over two and a half pages of the Office Action (pp. 19-22). Similarly, in the same Office Action, the Examiner rejected withdrawn claim 29 on over two and a half pages, i.e. pages 22-24, of the Office Action. In the same Office Action, the Examiner rejected withdrawn claims 22 and 30 on pages 25 – 27 and 27 – 29 respectively. In addition, withdrawn claims 10, 19, 21, 29 and 37 were examined in the same rejection as elected claims 1, 18, 20, 28 and 36.

Applicant finds it hard to believe that the amendments made to the claims in the amendment filed February 19, 2008, separate the claims into distinctly separate groups of sub-combinations which were never previously examined or rejected. For example, in order to distinguish the invention of claim 10 over the references cited by the Examiner in the Office Action dated November 27, 2007, Applicant added "via stream distribution" as well as "in its entirety". Furthermore, claim 21 was amended to state how the selecting means selects the advertisement image (i.e., selection is based upon received selection information from one of two

apparatuses). Based upon the Examiner's reasoning, election of embodiments/species would continue indefinitely based upon subtle amendments made to the claims whenever a RCE is filed. Thus, there can be no finality to any Office Action.

Applicant respectfully points out that there can be no serious burden on the Examiner since all claims in the present case have been examined by the Examiner in the five Office Actions subsequent to the initial election, including two Office Actions that were final. Applicant respectfully submits that all claims and all art in the present application must have been searched in these five Office Actions, and thus, respectfully submits that there can be no serious burden placed on the Examiner. Furthermore, Applicant respectfully submits that the restriction is improper under 37 C.F.R. § 1.142. Therefore, Applicant respectfully requests that this petition be granted, the restriction requirement withdrawn and a new Office Action examining claims 1-22, 28-30 and 32-37 should be issued.

Applicant respectfully submits that no petition fee is required for this Petition. However, in the event that the Director deem otherwise, any fees that may be due with respect to this paper, the Commissioner is authorized to charge our Deposit Account 50-0320.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicant respectfully petitions for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit
Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

Date: August 1, 2008

By: 

Ellen Marcie Emas
Reg. No. 32,131
(202) 292-1530